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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,140	03/31/2000	William P. Anderson	BLO1-134+006C	1755

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STANDLEY LAW GROUP LLP
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EXAMINER

KAZIMI, HANI M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,140

Applicant(s)

ANDERSON ET AL.

Examiner

Hani Kazimi

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 24. 6) ☐ Other: .

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DETAILED ACTION

1. This application has been reviewed. Original claims 1-14 are pending. The objections and rejections cited are as stated below:

Information Disclosure Statement

2. The information disclosure statements filed on March 31, 2000, and January 13, 2003 (papers numbers 2, and 4 respectively) contain duplicate references. All duplicate references have been eliminated from the 1449 forms by drawing a line across them.

Specification

3. The specification is objected to as not being in compliance with 37 C.F.R. § 1.77 regarding the required elements of the application. In particular, page 1 of the specification in the "Cross-References to Related Application" is lacking the patent number of the patented application serial number 08/902,239. Appropriate correction is required.

Claim Objections

4. Claim 13 is objected to under 37 CFR 1.75(a) for the following informality:
Claim 13 line 1, recites "claim 13". A claim cannot depend on itself, for purpose of examination only, Examiner assumes that claim 13 depends on claim 12.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, claims 1-14 include limitations such as “at least one financial information server--”, “at least one data server--”, “at least one identification server”, and “a communication link--”. However, the specification does not provide an enabling disclosure to support the claimed features “at least one financial information server--”, “at least one data server--”, “at least one identification server”, and “a communication link--”. For further examination purposes, examiner interprets the claims in light of the 35 U.S.C. 112, first paragraph rejection.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 8, is a system claim. However, there is no indication in the claim of any

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means or hardware that are performing the steps that are claimed. Furthermore, dependent claims 9-11 are referring to the method of claim 8, however, claim 8 is a system claim. For further examination purposes, examiner interprets claim 8 to be a method claim. Appropriate correction is required.

Double Patenting

9. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

10. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in the public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

11. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,706,442, and claims 1-14

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of U.S. Patent No. 6,131,115. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claims 1-14 essentially repeat all the features listed in claims 1-11 of US Patent No. 5,706,442, further recites the additional features of “wherein said client and said financial information server communicate in accordance with a binary interface”, which do not appear in the claims of the above mentioned Patents.

However, a binary interface communication between a client and a server is old and well known in the art.

Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to perform a binary interface communication between the client and the financial information server because, it greatly improves the efficiency of the system by providing an easier way of manipulating and processing the retrieved information.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claims, the deletion of “said request including said financial information server name”, “wherein said client is a hyper-text markup language browser”, “wherein said client is a presentation tool for an on-line information service”, and “wherein said communication link between said client and said financial information server is through an object-oriented application programming interface” from the patented claims would have been an obvious expedient as above.

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Claims 1-14 essentially repeat all the features listed in claims 1-14 of US Patent No. 6,131,115, further recites the additional features of “wherein said financial objects are two or more selected from the group consisting of a bill pay object, a card object, and a checking object”, which do not appear in the claims of the above mentioned Patents.

However, a bill pay object, a card object, and a checking object are old and well known in the art.

Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to include these type of objects because, it provides a user friendly system in performing remote accessing to banking information.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claims 1, 5, 8, and 12, the deletion of “said request including said financial information server name” from the patented claims would have been an obvious expedient as above.

Claims 1-7, and 12-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of co-pending Application No. 09/932,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and

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sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-7, and 12-14 essentially repeat all the features listed in claims 1-7, and 12-14 of co-pending Application No. 09/932,373.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant claims 1-7, and 12-14, the deletion of “comprising an identifier for locating said financial information server in accordance with said identification means for said financial information server” from the application claims would have been an obvious expedient as above.

12. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

13. In view of the 35 U.S.C. § 112, second paragraph rejection above;

Claims 8-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 8-11 of co-pending Application No. 09/932,373. This is a provisional double

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patenting rejection since the conflicting claims have not in fact been patented.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent May not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

16. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford US Pat. No. 5,812,776.

Claims 1-14, Gifford teaches a method and system for servicing information requests for Internet pages which reads on the method and system claimed. Gifford operates in an Internet system as shown in figure 1. Gifford's client (601) transmits an information request to a name server (602) which provides a location for retrieval of the requested information (603), (fig. 6). Gifford further discloses operation of a client (50) to request information at an authentication server (54) which responds with the location (New URL w/SID) for the client to retrieve the information from another server (52). Gifford discusses the well known operation of name servers in the HTTP/HTML Internet environment (columns 1-2) which further discloses the generic operation claimed by Applicant (columns 3-8).

Gifford fails to teach that the client and the financial information server communicate in accordance with a binary interface, and the information is financial information consisting of a bill pay, a card, and a checking.

Official Notice is taken that a binary interface communication between a client and a server, and communicating financial information consisting of a bill pay, a card, and a checking is

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old and well known in the art.

It would be obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Gifford to include a binary interface communication between the client and the financial information server, and to communicate financial information consisting of a bill pay, a card, and a checking because, it greatly improves the efficiency of the system by providing an easier way of manipulating and processing retrieved information by using a binary interface, and a user friendly system in performing remote accessing to banking information.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

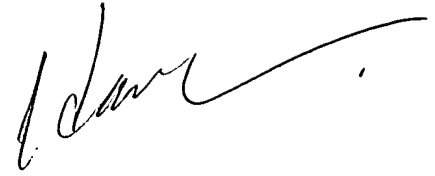
The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.

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A handwritten signature in black ink, appearing to read 'H. Kazimi', with a long horizontal flourish extending to the right.

HANI M. KAZIMI
PRIMARY EXAMINER

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October 1, 2003